

REMARKS

Telephone Interview With The Examiner

The undersigned thanks Examiner Ren L. Yan for the courtesy of a telephone interview conducted on April 14, 2004 with the undersigned, Michael J. Pomianek (Reg. No. 46,190). The following is a complete written statement of the substance of the interview and the reasons presented during the interviews as warranting favorable action, in accordance with the requirements of 37 C.F.R. §1.133(b).

During the interview of April 14, 2004, initiated by Mr. Pomianek, Mr. Pomianek requested clarification of the basis for the examiner finding that the Amendment previously submitted was not fully responsive for failing to point out how the language of independent claim 37 patentably distinguished it from the prior art reference (U.S. Pat. No. 4,497,249 to Mitter). Mr. Pomianek pointed out that remarks were presented on pages 17 and 18 of the Amendment that specifically discussed the patentability of claim 37 over Mitter and inquired as to whether the examiner had inadvertently failed to consider these remarks. Examiner Yan replied that he had considered the remarks but that, in his view, they failed to adequately explain how the amended language of claim 37 served to change the scope of the claim as previously pending so as to add limitations sufficient to distinguish Mitter as applied to the claim in the rejection under section 102(b) in the Office Action. Mr. Pomianek indicated that while he believed that the remarks provided in the Amendment were responsive and sufficient, he would respond in writing providing further clarification and explanation. This written response is presented below.

As indicated on page 11 of the previous Amendment, independent claim 37 was amended to convert a limitation in the preamble directed to the intended use of the claimed system, and which was not in means plus function format invoking section 112 paragraph 6, into a limitation in means plus function format invoking treatment under section 112 paragraph 6. For convenience, claim 37 as amended is reproduced below:

37. (Currently Amended) ~~In a~~ A system comprising: means for air embossing an embossable fabric by directing a stream of ~~air~~ gas through at least one opening in a rotating cylindrical stencil and onto an embossable surface of the fabric[~~],~~] ; and means for reducing variations in a distance separating the embossable surface of the fabric and a portion of a fabric-facing surface of the stencil directly adjacent thereto during rotation of the stencil.

This amended language changed the scope of the claim by limiting the literal scope of the claim to cover only systems comprising structure identical or equivalent to that recited in the Applicants' specification as corresponding to the recited function of air embossing an embossable fabric by directing a stream of gas through at least one opening in a rotating cylindrical stencil and onto an embossable surface of the fabric.

It is noted, in the first instance, that MPEP section 2183 places the initial burden of establishing a *Prima Facie* case equivalence of a prior art disclosed element with structure disclosed in an application corresponding to a function recited in a means plus function limitation on the examiner. Such a *Prima Facie* case requires that the examiner show that the prior art element:

- (1) perform the function specified in the claim;
- (2) not be excluded as a possible equivalent by any disclosure in the Applicants' specification; and
- (3) be an equivalent of the corresponding element disclosed in the Applicants' specification.

Furthermore, the showing of equivalency should include an explanation and rationale as to why the elements are equivalent (See MPEP section 2183).

Accordingly, it is believed that sufficiently responsive remarks pointing out the patentability of claim 37, as amended, by the Applicants could have been limited to simply pointing out that nowhere do the Applicants observe where Mitter appears to disclose any structure even capable of performing the recited function, let alone structure that is identical or equivalent to corresponding structure recited in Applicants' specification. It is believed that the burden would then be on the Patent Office to show otherwise by establishing a *Prima Facie* case of equivalency as outlined above.

Nevertheless, to expedite prosecution and further explain why a *Prima Facie* case of equivalency cannot be made, it was additionally pointed out on pages 17 and 18 of the Remarks section of the Amendment how the structure of Mitter identified in the Office Action as possibly enabling the system of Mitter to emit air within a stencil, is not configured to enable it to perform the function recited in the newly added means plus function limitation of amended claim 37, which would be a threshold showing required for finding anticipation of a 112, paragraph 6 limitation. Quoting from page 18 of the Amendment:

The structure corresponding to the recited means for air embossing disclosed in the present application comprises an air lance having a nozzle configured and positioned so that it is located with respect to the inner surface of a cylindrical stencil and configured so as to emit a stream of gas and direct the stream of gas through the at least one opening in the stencil with sufficient collimation and velocity to create a at least one visible embossed depressions in the surface of the fabric corresponding to the at least one opening in the stencil. As discussed above in the context of the rejection of independent claims 1 and 25, Mitter does not disclose or suggest such structure.

The relevant remarks from the discussion of claims 1 and 25, referred to in the above remarks directed to claim 37, indicating why the elements of system of Mitter that could potentially emit a gas within the stencil could not perform the recited function of air embossing an embossable fabric (i.e. creating visually discernable depressions in the fabric surface) by directing a stream of gas through at least one opening in a rotating cylindrical stencil and onto an embossable surface of the fabric include (quoting from pages 16 and 17 of the Amendment):

Furthermore, Mitter certainly does not appear to disclose or suggest that his system includes an air lance comprising at least one nozzle, wherein the nozzle is configured and positioned with respect to the inside surface of a stencil so that it is able to emit a stream of a gas supplied to the air lance such that the gas is directed to pass through openings in the stencil and, when the system is in operation, impinge upon the surface of the embossable fabric with sufficient velocity and collimation to create visible embossed depressions in the surface of the fabric in a pattern corresponding to a pattern of the openings in the stencil ...

While Mitter does possibly suggest the discharge of media such as air or gas from a nozzle of certain of his devices (see description of FIG. 11 and FIG. 12 embodiment at column 10, lines 32-50), the air or gas appears to be utilized either for forming a foamed liquid treating medium, which passes through the stencil and onto the substrate being treated, or for the pressurization of a flowable printing medium such as liquid ink or paste ink, which passes through the stencil and onto the substrate being treated. Nowhere does it appear that Mitter suggests that any of his systems are configured such that any gas that can be emitted from any nozzle of any of his devices so as to pass through the stencil so that it impinges on the surface of an embossable fabric....

Nevertheless, assuming for the sake of argument only, that Mitter did disclose a system configured so that it was able to directly discharge air or gas so that it could pass through the stencil, it is readily apparent in FIG. 12 that any structure potentially satisfying the definition of a nozzle given in the instant specification on page 10, lines 28-29 [e.g. opening of conduits (55) into the interior (206)] is not configured or positioned with respect to the inner surface of the stencil so as to be able to emit a stream of gas that has sufficient velocity to create visible embossed depressions in the surface of the fabric. Rather, the nozzles are widely spaced apart and separated from the stencil by a distance that appears to equal or exceed the radius of the stencil. Such a configuration, as would

be understood by those skilled in the art, would create poor collimation and uniformity. In the embodiment of FIG. 11, it appears that the air or gas is used to pressurize distensible hoses (33) and is not emitted from any nozzles at all.

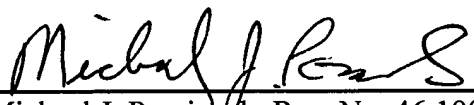
It is believed that the amendment to claim 37, and the remarks directed to explaining the patentability of claim 37 as amended over Mitter, provided in the previously submitted Amendment, as supplemented and explained by the remarks in the present submission are fully responsive to the rejection of claim 37 made in the previous Office Action. Accordingly, entry and consideration on the merits of the previously submitted Amendment, as supplemented by the present submission, is respectfully requested.

CONCLUSION

In view of the foregoing remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the examiner believes, after this amendment, that the application is not in condition for allowance, the examiner is requested to call the undersigned at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

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Date: April 29, 2004
x Due Date
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